



AF/ 2175 #

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		First Named Inventor	Teng, et al.
		Art Unit	2175
		Examiner Name	Mizrahi, Diane D.
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ENCLOSURES (check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Response <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> PTO/SB/08 <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Basic Filing Fee <input type="checkbox"/> Declaration/POA <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s)	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): <div style="border: 1px solid black; padding: 5px; margin-top: 10px;">Receipt Postcard Check for 330.00</div>
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FEE TRANSMITTAL for FY 2004

Effective 01/01/2004. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27.

TOTAL AMOUNT OF PAYMENT (\$) 330.00

Complete if Known

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First Named Inventor Teng, et al.
Examiner Name Mizrahi, Diane D.
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Attorney Docket No. 42390PT0833

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FEE CALCULATION

1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	
SUBTOTAL (1)					(\$)

2. EXTRA CLAIM FEES

Total Claims - 20** = X =
Independent Claims - 3 = X =
Multiple Dependent =

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1202	18	2202	9	Claims in excess of 20	
1201	86	2201	43	Independent claims in excess of 3	
1203	290	2203	145	Multiple Dependent claim, if not paid	
1204	86	2204	43	**Reissue independent claims over original patent	
1205	18	2205	9	**Reissue claims in excess of 20 and over original patent	
SUBTOTAL (2)					(\$)

**or number previously paid, if greater. For Reissues, see below

FEE CALCULATION (continued) MAY 27 2004

Technology Center 2100

3. ADDITIONAL FEES

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet.	
2053	130	2053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for ex parte reexamination	
1804	920 *	1804	920 *	Requesting publication of SIR prior to Examiner action	
1805	1,840 *	1805	1,840 *	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1404	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	330.00
1403	290	2403	145	Request for oral hearing	
1451	1,510	2451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	2460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	1809	385	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR § 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify) _____

* Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$) 330.00

SUBMITTED BY

Complete (if applicable)

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Signature [Signature] Date 05/21/04

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES



#12
6/19/04
A.W.

In re the Patent Application of:)
Teng et al.) Date: May 19, 2004
)
Serial No.: 09/752,799) Art Unit: 2175
Filed: December 28, 2000)
) Examiner: D. Mizrahi
For: METHOD AND APPARATUS)
TO SEARCH FOR)
INFORMATION)
_____)

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MAY 27 2004

Technology Center 2100

HONORABLE DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE,
Washington, D.C. 20231

APPEAL BRIEF

IN SUPPORT OF APPELLANTS' APPEAL
TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

Sir:

Applicants (hereafter "Appellants") hereby submit this Brief in triplicate in support of their Appeal from a final decision by the Examiner in the above-captioned case. Appellants respectfully request consideration of this Appeal by the Board of Patent Appeals and Interferences for allowance of the claims in the above-captioned patent application.

An oral hearing is not desired.

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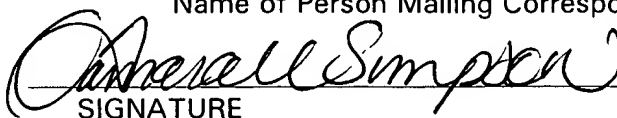
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A. REJECTION OF CLAIMS 1-15 (GROUP I) UNDER 35 U.S.C. § 103(a) ON MANN ET AL. IN VIEW OF MONAHAN ET AL. IS IMPROPER. THE COMBINATION DOES NOT EXPRESSLY OR INHERENTLY MEET CLAIM LIMITATIONS DIRECTED TO "IDENTIFYING, ACCORDING TO PROPERTIES RETURNED BY A PLURALITY OF SEARCH ENGINES, AT LEAST ONE SEARCH ENGINE SUITED TO SERVICE A QUERY" AND/OR LIMITATIONS RECITED IN THE DEPENDENT CLAIMS	7
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I. REAL PARTY IN INTEREST

The invention is assigned to Intel Corporation of 2200 Mission College Boulevard, Santa Clara, California 95052.

II. RELATED APPEALS AND INTERFERENCES

To the best of Appellants' knowledge, there are no appeals or interferences related to the present appeal that will directly affect, be directly affected by, or have a bearing on the Board's decision.

III. STATUS OF THE CLAIMS

Claims 1-15 are currently pending in the above-referenced patent application. Claims 1-15 were rejected in the Final Office Action mailed on January 5, 2004 and are the subject of this appeal. A copy of all claims on appeal, namely claims 1-15, is attached hereto as Appendix A. The Examiner confirmed her final rejection in an Advisory Action mailed on March 23, 2004.

Claims 1-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mann et al (U.S. patent 6,298,341) in view of Monahan et al (U.S. patent 6,523,037).

IV. STATUS OF AMENDMENTS

To the best of Appellants' knowledge, no amendments have been filed subsequent to the Final Rejection.

V. SUMMARY OF THE INVENTION

Searching for information on computer networks such as the internet is not only a popular activity it is often an important business activity. Traditionally two approaches have been used to search computer networks. The first approach is to buy or license proprietary search technology. It may be very expensive to install and maintain such technology on private network servers. Moreover, this approach ties the customer to using one search technology to service all queries. The second option utilizes search technology installed and maintained on a third party's servers under an application service provider (ASP) model. Using this approach, a customer's search queries are redirected from the customer's servers to the third party's servers where the search is conducted and the results returned to the customer. While the ASP model may lower acquisition and maintenance costs it is still tied to a particular search technology barring the customer deciding to switch search vendors wholesale. Thus, neither of the traditional approaches is capable of matching a particular search query to the search technology most suited to servicing that query. Therefore, a need exists for inter-search technology protocols to locate and match the best search technologies or "search engines" to service a particular search query. (Background, page 2, lines 10-21 to page 3, lines 1-5).

In particular, although the invention is not limited in this regard, a client system may interact through a web browser with a search manager of a server system to match a query to search engines most suited to locate the type information sought by the query using protocols in accordance with the invention. Protocols in accordance with the invention include facilities to pass queries to search engines and return results, and for exchanging search engine capabilities, user profile information, search logs and other information. Although the invention is not limited in this respect, the search manager may identify a suitable search engine to service a query based on content categories or scope restrictions associated with that query such as, for example, a date restriction (e.g., return only documents having a creation date later than a certain date), or content author, content language (e.g., English), etc. The search manager may, for example, identify a suitable search engine based on that search engine's properties such as the domains that it searches although the invention is not limited in this regard. (Specification, page 4, lines 7-23 to page 5, lines 1-15).

Simply stated, and referring, for example, to Figs. 2 and 5, Appellants' claimed invention includes, as just one embodiment, the method of storing two or more content categories (e.g., in server 107) and identifying (using, e.g., search manager 108), **based on the properties returned by two or more search engines** (e.g., the set comprising search engines 110, 202, 204, and 206), at least one search engine suited to service a query having at least one content category in common with the two or more stored content categories. (Specification, page 25, lines 1-5; FIGS. 2 and 5).

VI. ISSUES PRESENTED

- A. Whether claims 1-15 are patentable under 35 U.S.C. § 103(a) over Mann et al in view of Monahan et al.

VII. GROUPING OF CLAIMS

For the purposes of this appeal claims 1-15 stand or fall together as a single group.

VIII. ARGUMENT

REJECTION OF CLAIMS 1-15 (GROUP I) UNDER 35 U.S.C. § 103(a) ON MANN ET AL. IN VIEW OF MONAHAN ET AL. IS IMPROPER. THE COMBINATION DOES NOT EXPRESSLY OR INHERENTLY MEET CLAIM LIMITATIONS DIRECTED TO "IDENTIFYING, ACCORDING TO PROPERTIES RETURNED BY A PLURALITY OF SEARCH ENGINES, AT LEAST ONE SEARCH ENGINE SUITED TO SERVICE A QUERY" AND/OR LIMITATIONS RECITED IN THE DEPENDENT CLAIMS

The Examiner has rejected claims 1-15 as being unpatentable over Mann et al (U.S. patent 6,298,341) ("Mann") as applied to claim 1 below in view of Monahan et al (U.S. patent 6,523,037) ("Monahan"). Appellants note that the Examiner has applied the same rejection to the other independent claims 6 and 11. In her rejection made in the Office Action mailed on May 27, 2003, which she further confirmed in the Final Office Action mailed on January 5, 2004, the Examiner relies on Mann for teaching all the limitations of these claims except for the limitation of "a plurality of search engines." In this regard, the Examiner merely states, "Mann does not expressly teach the claimed, 'a plurality of search engines'." Therefore, the Examiner concedes that Mann does not teach a plurality of search engines.

Appellants do not believe that this represents a proper combination under section 103. Furthermore, even assuming, for the sake of argument, the combination were proper the combination would still fail to produce the subject matter of the rejected claims.

Claim Group

Claim 1 states:

storing a plurality of content categories; and

identifying, according to properties returned by a plurality of search engines, at least one search engine suited to service a query having at least one content category of the plurality of content categories.

An Embodiment of Appellants' Invention

As the embodiments of Figs. 1 and 2 show, a search manager in accordance with the invention may query a set of search engines for their properties so as to select the appropriate search engines to service a search query rather than servicing the query itself, although the invention is not limited in this respect and the search manager may also service the query. Moreover, one or more of the search engines themselves may query other search engines in the set of search engines for their properties using protocols in accordance with the invention and return those properties with its own properties in response to a query for properties from the search manager. (Specification, page 5, lines 16-22 to page 6, lines 1-22).

Although the invention is not limited in this regard, the search manager may identify a particular search engine (e.g., item 110 of Figs. 2 and 3) based on that search engine's properties and submit the query to locate information to that search engine, possibly specifying domain or scope restrictions for the search using protocols in accordance with the invention. The search engine 110 may service the query itself, and may also communicate the query to other search engines in the set of search engines (e.g., items 204 and 206 of Fig. 3) based, possibly, on properties associated with those search engines as identified using protocols in accordance with the invention. The search engines 204 and 206 identified by search engine 110 may attempt to service the query, and may return search results to search engine 110 where those search results may be merged with search engine 110's results and returned as merged results to the search manager. The search manager may return the merged results to the client that initiated the query to locate information. (Specification, page 7, lines 1-14).

Although the invention is not limited in this regard, defining or specifying one or more search engines to employ for servicing a query to locate information may utilize a scheme for mapping content categories associated with the query to suitable search engines. Content categories may comprise classifications of content; for example, "sports", "weather" etc., although the invention is not limited in this respect. Mapping may also include mapping to domains for locating content in content categories. A single content category, such as "sports" may comprise several or many domains some of which may be internal to an organization (i.e., an intranet), while others may be on the

World Wide Web. Moreover, although the invention is not limited in this respect, a set of one or more domains may be associated with a particular search engine and may comprise a set of one or more servers providing physical storage for documents. Thus, a search engine's properties may include the content categories or domains associated with that search engine. While the set of underlying web domains for a particular category may change, along with the associated search engines, the category itself will not (i.e., "sports" will remain "sports"). Mapping of selected content categories to suitable search engines may be accomplished by, for example, use of a lookup table or database that is kept current by using protocols to request the properties of available search engines whenever desired. It may also be possible to query a search engine for properties of its associated domains, such as the name and description of a domain or a range of dates associated with the information on the domain; to name only a few possibilities. (Specification, page 7, lines 16-23 and page 8, lines 1-23).

Protocols for implementing the invention with regard to establishing communications to exchange information or messages with search engines and for encoding data in those messages may comply with, but are not limited to complying with, Hypertext Transfer Protocol (HTTP) or Secure Hypertext Transfer Protocol (HTTPS). The format of messages exchanged or communicated may comprise, but are not limited to, Extensible Markup Language (XML) format, for example, while message syntax may comprise the Uniform Resource Locator (URL) syntax or the Structured Query Language (SQL), to name a few possibilities. The message scheme used may vary according to the particular message format and syntax. The protocols may also include facilities to retrieve a search engine's search activity logs comprising properties of other searches performed by the engine. The activity log properties may include the text or terms of the search query, the type of data returned (documents, statistics, etc.), time and date of search etc. (Specification, page 13, lines 8-23 and page 14, lines 1-14).

Summary of the Mann Reference

According to the Final Office Action in repeating the rejection made in the First Office Action, Mann teaches storing a plurality of content categories and identifying, according to properties returned by at least one search engine suited to service a query

having at least one content category of the plurality of content categories. However, Appellants respectfully assert that the Examiner has incorrectly characterized the teachings of the Mann reference. More significantly, the Final Office Action has applied the language recited in Appellant's claim 1 in a manner that is inconsistent with the explicit teachings of Mann.

Mann's invention relates to "systems and methods sued to facilitate registration" of domain names and URLs. (Mann, col. 1, lines 8-10). More specifically, Mann discloses a user accessible "domain name service and system" to supply users with "lists of available domain names based on user-specified criteria (root terms)." (Mann, col. 3, lines 40-45). In other words, Mann discloses a online system for generating registrable domain names to users who supply the system with root terms that the users desire to be incorporated into domain names that they may register. (Mann, col. 4, lines 35-40). Thus, Mann's disclosure is directed at solving the problem of selecting and registering domain names that best suit a particular user's purposes. (Mann, col. 2, lines 20-21).

Referring to Mann's Figs. 1-2 and 3A-D, a user of Mann's system would submit an online form requesting "one or more root terms for available domain names" such as, for example, a user desiring to register domain names incorporating the root term "tax" such as "taxmoney.com," "ustax.com," etc. (Mann, col. 4, lines 30-40; Fig. 3A, step S3-3). Next, the user specifies an email address for the system to send lists of available domain names to. (Mann, col. 4, lines 48-50; Fig. 3A, step S3-4). Mann's system then concatenates the user-specified root terms with "adjunct terms" (e.g., prefixes, suffixes, etc.) "specified in (an) adjunct database" to generate a list of "candidate domain names." (Mann, col. 4, lines 55-58; Fig. 3A, step S3-5). Mann's system then checks the candidate domain names against an internal database and if a match is found then that domain name is labeled as not available (and thus dropped from the list of registrable domain names ultimately presented to the user). (Mann, col. 5, lines 19-21; Fig. 3A, steps S3-6,7). Candidate names that survive step S3-6 are checked against the external InterNIC database. (Mann, col. 5, lines 34-37; Fig. 3B, step S3-9). Appellants note that InterNIC is a registered service mark of the U.S. Department of Commerce and that the InterNIC website and associated database are operated by the Internet Corporation for Assigned Names and Numbers (ICANN).

Simply stated, Mann discloses a system and method for generating candidate domain names from a user's desired root term and checking those candidate domain names against a specific external database known to contain all registered domain names (i.e. InterNIC). The "search" function shown in Fig. 5A of Mann simply refers to Mann's disclosed method for searching for matches against registered domain names stored on the InterNIC database and not against the internet in general.

Summary of the Monahan Reference

According to the Final Office Action in repeating the rejection made in the First Office Action, Monahan teaches the "plurality of search engines" that Mann fails to teach. However, Appellants respectfully assert that the Examiner has incorrectly applied the teachings of the Monahan reference in an attempt to combine Monahan with Mann.

Monahan's invention relates to "the field of network-based communications." (Monahan, col. 1, lines 8-9). More specifically, Monahan discloses a "method of communicating a selected subset of data items between multiple entities over a network." (Monahan, col. 1, lines 10-11). Monahan's disclosed system addresses the problem of transmitting between two entities, in the context an Internet-based auction facility, only the most relevant information resulting from a query for information. (Monahan, col. 2, lines 17-28).

Because the Examiner has relied upon Monahan only to the extent that Monahan mentions the existence of multiple commercial search engine technologies (e.g., those developed by Google Incorporated, Alta Vista, Inc., etc.), Appellants will not describe Monahan's disclosure in further detail.

Under 103(a) the claimed invention as a whole must be considered

Appellants notes that in determining the differences between the alleged prior art and the claimed invention the question for the Examiner is not whether "the differences themselves would have been obvious, but whether the invention as a whole would have been obvious." (emphasis in original). MPEP 2141.02 (citing Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530 (Fed. Cir. 1983)). In making her rejection, the Examiner has relied upon Monahan's teaching of multiple search engines to supplement the inadequate

teachings of Mann. (Final Office Action, page 5). However, Appellants assert that the Examiner has failed to properly read the limitations of claim 1 as reflects the claimed invention as a whole. **Claim 1 clearly recites identifying at least one search engine “according to properties returned by a plurality of search engines” (emphasis added).** (Claim 1, line 3). Thus, by considering Mann’s disclosure to be deficient for only failing to disclose “a plurality of search engines” the Examiner has failed to consider obviousness in the context of the claimed invention as a whole.

Appellants assert that Mann fails to disclose the claimed limitation of identifying at least one search engine “according to properties returned by a plurality of search engines” (emphasis added). If, as the Examiner concedes, Mann fails to disclose a plurality of search engines (Final Office Action, page 5), then Mann must also fail to disclose properties returned by a plurality of search engines. Hence, **for the Examiner to properly determine obviousness in the context of the claimed invention as a whole she must show how Monahan teaches a plurality of search engines returning properties that enable a method of identifying at least one search engine according to those properties.**

Thus, Appellants do not believe that Mann with Monahan represents a proper combination under section 103. Thus, it is respectfully asserted that the Examiner has failed to meet her burden of establishing a *prima facie* case of unpatentability under 35 U.S.C. § 103. Even assuming, without conceding, that the combination asserted by the Examiner is proper, the Mann reference does not relate, nor is it analogous to the subject matter of the claimed invention.

Mann relates to a method and system for registering domain names and not to a method or system for identifying search engines best suited to servicing a query

Mann’s teachings are directed towards the solution of expediting the identification of registrable domain names. (Mann, col. 2, lines 19-21). Mann clearly teaches that candidate domain names are cleared against only one external database housed at one external website (i.e., InterNIC). (Mann, col. 5, lines 34-37). Thus, Appellants assert that **Mann does not teach, nor does Mann require, a method or system for ascertaining the properties of a plurality of search engines – Mann teaches a system that already knows where to obtain the desired information.** Hence Mann is not analogous to the

claimed invention. The Examiner cites one search engine in Mann (i.e., Fig. 5A "search button") suited to service a query (i.e., Fig. 5A, item #507) but does not explain how that search engine is identified according to properties returned by a plurality of search engines in accordance with the claimed invention. Appellants respectfully assert that the Examiner has not done so precisely because Mann already knows where to find information regarding registered domain names.

Nonetheless, even assuming, for the sake of argument, that Mann relates to or is analogous to the subject matter of the claimed invention and assuming, once again, for the sake of argument, that the combination produced the claimed limitations, the combination would still fail for not being based on a proper motivation or suggestion.

Obviousness must be assessed within the context of what the prior art as a whole would have suggested to one of ordinary skill in the art at the time of the invention

A *prima facie* case of obviousness can

only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art (emphasis added)

MPEP 2143.01 (citing In re Kotzab, 217 F.3d 1365 (Fed. Cir. 2000)).

The Examiner has asserted that

it would have been obvious to a person of ordinary skill in the art at the time of

Applicant's invention to modify the teachings of Mann with the teachings of Monahan to include a plurality of search engines with the motivation to allow a user to a particular web site that might be of interest (Monahan, col. 1, lines 26-33) (Final Office Action, page 5).

Appellants assert that if, as the Examiner claims, it is Monahan that supplies the motivation to combine, then it should be the Monahan disclosure that is modified to incorporate the teachings of Mann and not, as the Examiner's rejection clearly sets forth, that the Mann disclosure should be modified by the teachings of Monahan. In other

words, Appellants assert that it is Mann that should provide the motivation to modify its teachings by incorporating the “plurality of search engines” taught by Monahan.

Appellants assert that one of ordinary skill in the art having read and understood the disclosure of Mann would not look toward the teachings of Monahan. In particular, Mann’s teachings are directed towards the solution of expediting the identification of registrable domain names. (Mann, col. 2, lines 19-21). In doing so, Mann clearly teaches that candidate domain names are cleared against only one external database housed at one external website (i.e., InterNIC). Only the InterNIC database serves as an authoritative source of information on registered domain names. Thus, **Mann provides no motivation for one of ordinary skill in the art to modify a disclosure that relies upon a known website-accessible database to include a plurality of search engines returning properties to enable identification of a particular search engine – Mann’s disclosure has no need for multiple search engines.** Appellants respectfully assert that the Examiner has failed to adhere to the admonition that a *prima facie* case of obviousness can only be established by providing “some objective reason to combine the teachings of the references.” MPEP 2143.01 (citing Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)).

Nonetheless, even assuming, for the sake of argument, that Mann or, for that matter, Monahan provides proper motivation to combine, the combination would still fail because to incorporate the teachings of Monahan into Mann would change the principle of operation of Mann.

The proposed modification cannot change the principle of operation of a reference

If the Examiner’s asserted combination or modification would “change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” MPEP 2143.01 (citing In re Gordon, 733 F.2d 900 (Fed. Cir. 1984)). The Examiner argues that it would be obvious to modify the teachings of Mann with the teachings of Monahan. (Final Office Action, page 5). But to do so would change the principle of operation of Mann’s invention. As discussed in detail above, Mann discloses a method and system for identifying registrable internet domain names. Appellants assert that, assuming for the sake of argument that

the asserted combination produces the subject matter of the rejected claims, which Appellants assert it does not, **modifying Mann with Monahan by incorporating a plurality of search engines returning properties of those search engines would supply no useful function to Mann's teachings and, moreover, would only divert resources (e.g., network communications bandwidth) from Mann's disclosed purpose of clearing candidate domain names against the InterNIC database.**

Therefore, Appellants do not believe that this represents a proper combination under section 103. Furthermore, even assuming, for the sake of argument, the combination were proper the combination would still fail to produce the subject matter of the rejected claims.

Finally, even were the combination asserted by the Examiner to produce the invention as recited in claim 1, for example, which Appellants assert it does not, the Examiner has not provided the necessary suggestion or motivation to make the asserted combination.

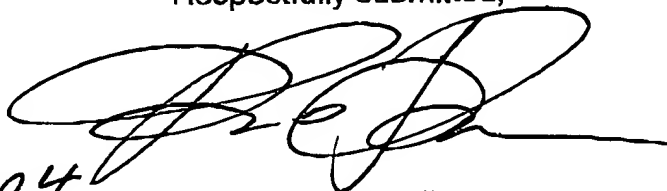
As previously stated, the main reference cited by the Examiner, namely Mann, is not related, nor is it analogous, to the claimed subject matter, as was previously discussed in detail. Moreover, the asserted combination would change the principle of operation of the main reference. Under these circumstances, the combination would not render the claimed subject matter obvious as one of ordinary skill in the art would not look to Mann in solving the particular problem addressed by the Appellants. Based on the foregoing, it is respectfully asserted that claims 1-15 recite patentable subject matter.

IX. CONCLUSION

Appellants respectfully submit that all the pending claims in this patent application are patentable and request that the Board of Patent Appeals and Interferences overrule the Examiner and direct allowance of the rejected claims.

This brief is submitted in triplicate, along with a check for \$320.00 to cover the appeal fee for one other than a small entity as specified in 37 C.F.R. § 1.17(c). Please charge any shortages and credit any overcharges to Deposit Account No. 02-2666.

Respectfully submitted,



Date: May 20, 2004

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X. APPENDIX A: CLAIMS ON APPEAL

1. A method comprising:
storing a plurality of content categories; and
identifying, according to properties returned by a plurality of search engines,
at least one search engine suited to service a query having at least one content category
of the plurality of content categories.
2. The method of claim 1 in which identifying the at least one search engine
further comprises:
identifying at least one domain of the at least one search engine suited to
service the query.
3. The method of claim 1 further comprising:
analyzing the content of a query to determine the at least one content
category of the query; and
identifying at least one domain of the at least one search engine suited to
service the query according to the content category.
4. The method of claim 2 in which identifying at least one domain of the at
least one search engine suited to service the query further comprises:
identifying the at least one domain according to a scope of the query.
5. The method of claim 1 in which at least one content category of the plurality
of content categories further comprises:
child categories.
6. An article comprising:
a machine-readable medium comprising instructions which, when executed
by a processor, result in:
storing a plurality of content categories; and

identifying, according to properties returned by a plurality of search engines, at least one search engine suited to service a query having at least one content category of the plurality of content categories.

7. The article of claim 6 in which execution of the instructions to identify the at least one search engine further results in:

identifying at least one domain of the at least one search engine suited to service the query.

8. The article of claim 6, further comprising instructions which, when executed by the processor, result in:

analyzing the content of a query to determine the at least one content category of the query; and

identifying at least one domain of the at least one search engine suited to service the query according to the content category.

9. The article of claim 7 in which execution of the instructions to identify the at least one domain of the at least one search engine suited to service the query further results in:

identifying the at least one domain according to a scope of the query.

10. The article of claim 6 in which at least one content category of the plurality of content categories further comprises:

child categories.

11. A system comprising:

a processor; and

a machine-readable medium comprising instructions which, when executed by the processor, result in:

storing a plurality of content categories; and

identifying, according to properties returned by a plurality of search engines, at least one search engine suited to service a query having at least one content category of the plurality of content categories.

12. The system of claim 11 in which execution of the instructions to identify the at least one search engine further results in:

identifying at least one domain of the at least one search engine suited to service the query.

13. The system of claim 11, further comprising instructions which, when executed by the processor, result in:

analyzing the content of a query to determine the at least one content category of the query; and

identifying at least one domain of the at least one search engine suited to service the query according to the content category.

14. The system of claim 12 in which execution of the instructions to identify the at least one domain of the at least one search engine suited to service the query further results in:

identifying the at least one domain according to a scope of the query.

15. The system of claim 11 in which at least one content category of the plurality of content categories further comprises:

child categories.